UNITED STATES PATENT AND TRADEMARK OFFICE

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09/770,694	01/26/2001	Christopher M. Connors	M-9723 US	6814

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Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/770,694	CONNORS ET AL.
		Examiner	Art Unit
		Nicholas D. Rosen	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 July 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-69</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-69</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>26 January 2001</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4, 5, 7/8/04</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claims 1-69 have been examined.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: web page 400 (mentioned in several places on page 150), cursor 60 (mentioned on page 15, line 18), web page 500, mentioned in several places on page 17, and hypertext link 870 (mentioned on page 18, line 21). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract

on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because, at 185 words, it exceeds the permitted length. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: In the Preliminary Amendment of May 9, 2001, instructions are given to replace the paragraph regarding Fig. 6 in the Brief Description of the Drawings on page 6, lines 12-14 with a paragraph regarding Fig. 6A and 6B, which is proper. However, instructions are then given to replace the paragraph regarding Fig. 22 with a paragraph regarding Fig. 22A and 22B, *also on page 6, lines 12-14*, which is an error. The amended paragraph regarding Figures 22A and 22B should go on page 8, lines 3-4.

On page 25, line 12, "computer system 210" does not correspond to the numbering of elements in the drawings, and should presumably be "computer system 10".

Appropriate correction is required.

Claim Objections

Claim 37 is objected to because of the following informalities: "said needs analysis module" lacks antecedent basis. Appropriate correction is required.

Claims 51-56 are objected to because of the following informalities: There should be a comma after "product" in claim 51, since it is the method, not the product, which comprises the listed steps. Appropriate correction is required.

Claims 57-61 are objected to because of the following informalities: There should be a comma after "product" in claim 57, since it is the method, not the product, which comprises the listed steps. Also, in the second line of claim 57, "an product identifier" should be 'a product identifier". Appropriate correction is required.

Claims 62-69 are objected to because of the following informalities: There should be a comma after "product" in claim 62, since it is the method, not the product, which comprises the listed steps. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-23 and 49-50 are rejected under 35 U.S.C. 101 because the claims are directed to an abstraction not within the technological arts ("technological arts" being considered equivalent to "useful arts," mentioned in Article I, Section 8 of the United States Constitution, saying that Congress shall have "power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writing and Discoveries" – see *In re Musgrave*, 431 F.2d 882, 167 USPQ [CCPA 1970]). The claims are directed to a "software architecture," which may be a computer program *per se*, which is functional descriptive

material, and not patentable. A "software architecture" as such is not a "process, machine, manufacture, or composition of matter," and is therefore not patentable.

Examiner suggests that the "software architecture" be claimed in the form, "A computer program for doing X, said program embodied in a computer-readable medium, said program comprising computer-executable instructions which cause a computer to perform: the step of X1; the step of X2; and the step of X3."

Claims 24-35 are rejected under 35 U.S.C. 101 because the claims are directed to an abstraction not within the technological arts, on the same grounds set forth above in rejecting claim 1 and its dependents.

Claims 36-48 are rejected under 35 U.S.C. 101 because the claims are directed to an abstraction not within the technological arts, on the same grounds set forth above in rejecting claim 1 and its dependents.

Claims 51-56 are rejected under 35 U.S.C. 101 because the claims are directed to a method not within the technological arts ("technological arts" being considered equivalent to "useful arts," mentioned in Article I, Section 8 of the United States Constitution, saying that Congress shall have "power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writing and Discoveries" – see *In re Musgrave*, 431 F.2d 882, 167 USPQ [CCPA 1970]). The claims are directed to a method that does

nothing more than manipulate an abstract idea. To be patentable, a method claim must produce a useful, concrete, and tangible result, or involve a step or act of manipulating technology (see *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d. at 1452). A method for identifying a product may be, in a sense, useful, but is not concrete or tangible.

Although claim 51 recites querying a database, a database need not necessarily be an electronic database, and claim 51 does not recite computer-implemented or other technological manipulation of the database in carrying out the step of identifying a product identifier corresponding to an attribute by causing a filter service to query a database. The claim language could be met by instructing a "filter service" consisting of one or more human clerks to query a database consisting of papers in a filing cabinet.

Claims 57-61 are rejected under 35 U.S.C. 101 because the claims are directed to a method not within the technological arts ("technological arts" being considered equivalent to "useful arts," mentioned in Article I, Section 8 of the United States Constitution, saying that Congress shall have "power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writing and Discoveries" – see *In re Musgrave*, 431 F.2d 882, 167 USPQ [CCPA 1970]). The claims are directed to a method that does nothing more than manipulate an abstract idea. To be patentable, a method claim must produce a useful, concrete, and tangible result, or involve a step or act of manipulating technology (see *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d. at

1452). A method for identifying a product may be, in a sense, useful, but is not concrete or tangible.

Although claim 57 recites querying a database, a database need not necessarily be an electronic database, and claim 57 does not recite computer-implemented or other technological manipulation of the database in carrying out the step of identifying a product identifier corresponding to a product by causing a configuration service to query a database. The claim language could be met by instructing a "configuration service" consisting of one or more human clerks to query a database consisting of papers in a filing cabinet.

Claims 62-69 are rejected under 35 U.S.C. 101 because the claims are directed to a method not within the technological arts ("technological arts" being considered equivalent to "useful arts," mentioned in Article I, Section 8 of the United States Constitution, saying that Congress shall have "power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writing and Discoveries" – see *In re Musgrave*, 431 F.2d 882, 167 USPQ [CCPA 1970]). The claims are directed to a method that does nothing more than manipulate an abstract idea. To be patentable, a method claim must produce a useful, concrete, and tangible result, or involve a step or act of manipulating technology (see *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d. at 1452). A method for identifying a product may be, in a sense, useful, but is not concrete or tangible.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6, 14, 19 and 49

Claims 1, 2, 3, 6, 14, 19, and 49 are rejected under 35 U.S.C. 102(e) as being

anticipated by Beesley et al. (U.S. Patent 5,907,320). As per claim 1, Beesley discloses

a software architecture (Abstract; column 6, line 44, through column 7, line 13)

comprising: a database layer (Abstract; column 3, lines 36-41; column 4, line 53,

through column 5, line 30); a services layer, coupled to said database layer (Abstract;

column 3, line 4, through column 5, line 30); and a needs analysis module, coupled to

said services layer (column 5, lines 15-30; column 13, lines 12-57; column 14, lines 31-

54; column 15, lines 1-19).

As per claim 2, Beesley discloses that the needs analysis module is configured to

permit identification of a product based on attribute information (column 5, lines 15-30;

column 13, lines 12-57; column 14, lines 31-54).

As per claim 3, Beesley discloses that the service layer comprises a filter service

(column 3, line 4, through column 5, line 30).

As per claim 6, Beesley discloses that the database layer comprises a database (Abstract; column 3, lines 36-41; column 4, line 53, through column 5, line 30); and said database comprises product identifier information, attribute information, and configuration information (column 4, line 12, through column 5, line 30).

As per claim 14, Beesley discloses that said services layer comprises a configuration service (Abstract; column 3, line 4, through column 5, line 30; column 13, lines 12-57).

As per claim 19, Beesley discloses that the database layer comprises a database (Abstract; column 3, lines 36-41; column 4, line 53, through column 5, line 30); and said database comprises product identifier information and configuration information (column 4, line 12, through column 5, line 30).

As per claim 49, Beesley discloses a presentation layer and a controls layer, at least in the sense that information is presented to the user, and the operations of the whole system are controlled (Abstract; column 3, line 4, through column 5, line 30). Beesley further discloses that the presentation layer and controls layer are configured to provide an attribute selection to the needs analysis layer (column 5, lines 15-30; column 13, lines 12-57; column 14, lines 31-54).

Claims 24-26 and 29

Claims 24, 25, 26, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Beesley et al. (U.S. Patent 5,907,320). As per claim 24, Beesley discloses a software architecture (Abstract; column 6, line 44, through column 7, line 13) comprising: a database layer (Abstract; column 3, lines 36-41; column 4, line 53,

through column 5, line 30); and a services layer, wherein said services layer is coupled to said database layer and comprises a filter service (Abstract; column 3, line 4, through column 5, line 30).

As per claim 25, Beesley discloses that the filter service is configured to permit identification of a product based on attribute information (column 5, lines 15-30; column 13, lines 12-57; column 14, lines 31-54).

As per claim 26, Beesley discloses that the software architecture comprises a module layer, coupled to said services layer, wherein said module layer comprises a needs analysis module (column 5, lines 15-30; column 13, lines 12-57; column 14, lines 31-54; column 15, lines 1-19).

As per claim 29, Beesley discloses that the database layer comprises a database (Abstract; column 3, lines 36-41; column 4, line 53, through column 5, line 30); and said database comprises product identifier information, attribute information, and configuration information (column 4, line 12, through column 5, line 30).

Claims 36, 39, and 44

Claims 36, 39, and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Beesley et al. (U.S. Patent 5,907,320). As per claim 36, Beesley discloses a software architecture (Abstract; column 6, line 44, through column 7, line 13) comprising: a database layer (Abstract; column 3, lines 36-41; column 4, line 53, through column 5, line 30); and a services layer, wherein said services layer is coupled to said database layer, and comprises a configuration service (Abstract; column 3, line 4, through column 5, line 30; column 13, lines 12-57).

As per claim 39, Beesley discloses a module layer, coupled to said services layer, wherein said module layer comprises a needs analysis module (column 5, lines 15-30; column 13, lines 12-57; column 14, lines 31-54; column 15, lines 1-19).

As per claim 44, Beesley discloses that the database layer comprises a database (Abstract; column 3, lines 36-41; column 4, line 53, through column 5, line 30); and said database comprises product identifier information and configuration information (column 4, line 12, through column 5, line 30).

Claims 51 and 52 (anticipated by O Leary)

Claims 51 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by O Leary ("CompuServe Is 'Loaded' with Online Car Info"). As per claim 51, O Leary discloses a method for identifying a product, the method comprising: providing an attribute to a filter service; identifying a product identifier corresponding to said attribute by causing said filter service to query a database using said attribute; and causing said filter service to return said product identifier (paragraphs beginning "CompuServe's most familiar car database" and "Instead of being subsumed"; querying a database using the attribute is held to be inherent).

As per claim 52, O Leary discloses that said product identifier is associated with a product configuration, and said product configuration represents a product having said attribute (paragraphs beginning "CompuServe's most familiar car database" and "Instead of being subsumed").

Claims 51 and 52 (anticipated by Beesley)

Claims 51 and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by

Beesley et al. (U.S. Patent 5,907,320). As per claim 51, Beesley discloses a method for

identifying a product, comprising: providing an attribute to a filter service (column 4, line

59, through column 5, line 30; column 13, lines 12-57; column 14, lines 31-54);

identifying a product identifier corresponding to said attribute by causing said filter

service to query a database using said attribute (column 4, line 59, through column 5,

line 30; column 7, lines 1-13; column 13, lines 12-57; column 14, lines 31-54); and

causing said filter service to return said product identifier (column 5, lines 15-30; column

13, lines 12-57; column 14, lines 31-54).

As per claim 52, Beesley discloses that said product identifier is associated with

a product configuration, and the product configuration is associated with a product

having the attribute (column 4, line 59, through column 5, line 30; column 13, lines 12-

57; column 14, lines 31-54).

Claims 57 and 58

Claims 57 and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by

Beesley et al. (U.S. Patent 5,907,320). As per claim 51, Beesley discloses a method for

identifying a product, comprising: providing a product identifier to a configuration service

(column 5, lines 15-30; column 13, lines 12-57); identifying a product configuration

corresponding to said product identifier by causing said configuration service to query a

database using said product identifier (column 4, line 53, through column 5, line 30;

column 13, lines 43-57); and causing said configuration service to return said product

configuration (column 5, lines 15-30; column 13, lines 12-57).

As per claim 58, Beesley discloses that said product identifier is associated with

a product configuration in said database (column 4, line 53, through column 5, line 30;

column 13, lines 43-57).

Claims 62-66 and 69

Claims 62-66 and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by

O Leary ("CompuServe Is 'Loaded' with Online Car Info"). As per claim 62, O Leary

discloses a method for identifying a product, the method comprising: selecting a

selected feature from a plurality of features, wherein said product is one of a plurality of

products, said product is configured with said selected feature, each of said products is

configured with at least one of said features; determining which of said products is

configured with said selected features (the determining being inherent); and identifying

said product as being configured with said selected feature (paragraph beginning

"Instead of being subsumed").

As per claim 63, O Leary discloses that said selected feature is one of a plurality

of selected features (paragraph beginning "Instead of being subsumed," especially the

plural word "criteria"); and that said selected features form a product configuration

(paragraph beginning "Instead of being subsumed"). The product configuration must

inherently be an allowable configuration, for a non-empty list of vehicles to be displayed.

As per claim 64, O Leary discloses that said product is a vehicle (paragraph

beginning "Instead of being subsumed").

As per claim 65, O Leary discloses that said selected feature can be a make of said vehicle (paragraph beginning "Instead of being subsumed").

As per claim 66, O Leary discloses that said selected feature can be a model of said vehicle (paragraph beginning "Instead of being subsumed").

As per claim 69, O Leary discloses that said selected feature can be one of a price range, a vehicle type, an engine type, a fuel economy, an interior feature and a safety feature (paragraph beginning "Instead of being subsumed").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4-5, 7-13, 15-18, 20-23, and 50

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Beesley (U.S. Patent 5,907,320) as applied to claim 3 above. As per claim 4, Beesley

does not expressly disclose that the filter service is configured to provide a product

identifier to said needs analysis module in response to a product attribute received from

said needs analysis module, but discloses that a product is identified in response to a

product attribute or attributes, and also that the product identifier identifies a product,

and the product attribute is an attribute of the product (column 5, lines 15-30; column

13, lines 12-57; column 14, lines 31-54). Hence, it would have been obvious to one of

ordinary skill in the art of electronic commerce at the time of applicant's invention for the

filter service to be appropriately configured, in order to carry out the disclosed functions

of the software in Beesley's invention.

As per claim 5, Beesley discloses that said database layer comprises a database

(Abstract; column 3, lines 36-41; column 4, line 53, through column 5, line 30); and that

the filter service is configured to use said product attribute to retrieve the product

identifier from the database (column 3, line 4, through column 5, line 30; column 13,

lines 12-57).

Claims 7, 8, 9, 10, 11, and 12 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Beesley et al. (U.S. Patent 5,907,320) as applied to claim 6 above,

and further in view of the Microsoft Press Computer Dictionary. As per claim 7, Beesley

does not disclose that the database comprises a configuration table and an attribute

table, but the Microsoft Press Computer Dictionary teaches the use of tables in

databases (definition of table, senses 1 and 2, page 459). Hence, it would have been

obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention to have the database comprise tables, specifically a configuration

table and an attribute table, for the obvious advantage of linking relevant data, and

enabling efficient access.

As per claim 8, Beesley does not expressly disclose that the configuration table

contains product identifier information and configuration information, but the use of

tables being obvious (as set forth above, regarding claim 7), storing these particular

kinds of information in the configuration table would have been obvious to one of

ordinary skill in the art of electronic commerce at the time of applicant's invention.

As per claim 9, Beesley does not disclose that the tables comprise records

comprising fields which contain corresponding information (attribute information in an

attribute field, etc.), but the Microsoft Press Computer Dictionary teaches the use of

fields in databases (definition of field, sense 1, page 194). Hence, it would have been

obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention to have the tables comprise records comprising fields which

contain corresponding information, for the obvious advantage of enabling data to be

stored using standard techniques for easy storage and access.

As per claim 10, Beesley discloses that said configuration information describes

a configuration of a product; said attribute information describes an attribute of a

product; and said configuration of said product includes said attribute of said product

(column 3, line 4, through column 5, line 30; column 13, lines 12-42).

As per claim 11, Beesley discloses that the needs analysis module is configured to access the configuration information and that the filter service is configured to access the database using attribute information (column 3, line 4, through column 5, line 30; column 13, lines 12-57; column 14, lines 31-54; column 15, lines 1-19). Beesley does not expressly disclose that the needs analysis module is configured to supply attribute information to the filter service, but this is a mere verbal reshuffling. One can describe whatever module of Beesley's system supplies attribute information to the module that does the filtering as the need analysis module.

As per claim 12, Beesley discloses by inherency that a reference to a configuration record allows the filter service to access the configuration record according to attribute information, and therefore to access attribute records using attribute information (column 5, lines 15-30; column 13, lines 12-57; column 14, lines 31-54).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beesley et al. (U.S. Patent 5,907,320) as applied to claim 1 above, and further in view of O Leary ("CompuServe Is 'Loaded' with Online Car Info"). Beesley does not expressly disclose that the needs analysis module is configured to permit identification of a product configuration based on product identifier information, but O Leary teaches identifying a product configuration based on product identifier information (paragraph beginning "Instead of being subsumed"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the needs analysis module to be configured to permit identification of a product

configuration based on product identifier information, for the obvious advantage of

enabling users to obtain configuration information for vehicles and other products which

they had identified for research and possible purchase.

Claims 15, 16, 17, and 18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Beesley et al. (U.S. Patent 5,907,320) as applied to claim 14 above.

As per claim 15, Beesley does not expressly disclose that the configuration service is

configured to provide a configuration list to the needs analysis module in response to a

product identifier received from the needs analysis module, but one can define whatever

software module is involved in providing lists of the attributes of the various products in

Beesley's system as a configuration service, and Beesley does disclose comparing

product identifiers identifying products with configuration/attribute data for products, to

determine which products match listed attributes (Abstract; column 3, line 4, through

column 5, line 30; column 13, lines 12-57).

As per claim 16, Beesley does not expressly disclose that said configuration list

is a list of the available features of said product, but such a list of available features

would have been obvious for the purpose of enabling Beesley's system to carry out its

function of determining which, if any, available products match user-desired attributes

(Abstract; column 3, line 4, through column 5, line 30; column 13, lines 12-57).

As per claim 17, Beesley does not expressly disclose that said configuration list

is a list of the configurations of said product, but such a list of configurations would have

been obvious for the purpose of enabling Beesley's system to carry out its function of

determining which, if any, available products match user-desired attributes (Abstract; column 3, line 4, through column 5, line 30; column 13, lines 12-57).

As per claim 18, Beesley discloses that the database layer comprises a database (Abstract; column 3, lines 36-41; column 4, line 53, through column 5, line 30). Beesley does not expressly disclose that the configuration service is configured to use the product identifier to generate the configuration list from information stored in the database, but given that configuration/attribute information for products stored in the database are compared to attributes to determine which products match listed attributes (Abstract; column 3, line 4, through column 5, line 30; column 13, lines 12-57), generating such configuration lists is held to be obvious, to make the system able to carry out its functions.

Claims 20, 21, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beesley et al. (U.S. Patent 5,907,320) as applied to claim 19 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 20, Beesley does not disclose that the database comprises a configuration table containing product identifier information and configuration identification, but the Microsoft Press Computer Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise a configuration table containing information in the database, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 21, Beesley discloses that the needs analysis module is configured to access the configuration information, and that the configuration service is configured to access the database (Abstract; column 3, line 4, through column 5, line 30; column 13, lines 12-57; column 14, lines 31-54). Beesley does not expressly disclose that the needs analysis module supplies product identifier information to the configuration service (as well as to the user of the system), or that the configuration service uses product identifier information to access the database. However, this is a mere verbal reshuffling. One can describe whatever module of Beesley's system is involved in receiving the product identifier information (e.g., to be passed to the user) as a configuration service, and whatever module uses a product identifier to access the database (e.g., in comparing identified products to desired attributes) as a configuration service.

As per claim 22, Beesley does not disclose that the configuration table comprises a configuration record comprising configuration and identifier fields which contain corresponding information, but the Microsoft Press Computer Dictionary teaches the use of fields in databases (definition of field, sense 1, page 194). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the configuration table comprise records comprising fields which contain corresponding information, for the obvious advantage of enabling data to be stored using standard techniques for easy storage and access.

As per claim 23, Beesley discloses that said configuration information describes a configuration of the product (column 4, line 12, through column 5, line 30; column 13,

lines 12-57; column 14, lines 31-54), and product identifier information identifies the

configuration of the product (column 4, line 12, through column 5, line 30; column 13,

lines 12-57; column 14, lines 31-54).

Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beesley

et al. (U.S. Patent 5,907,320) as applied to claim 1 above, and further in view of O

Leary ("CompuServe Is 'Loaded' with Online Car Info"). Beesley discloses a

presentation layer and a controls layer, at least in the sense that information is

presented to the user, and the operations of the whole system are controlled (Abstract;

column 3, line 4, through column 5, line 30). Beesley does not expressly disclose that

the presentation layer and controls layer are configured to provide a product identifier

selection to the needs analysis layer, at least if one identifies the needs analysis layer in

Beesley as being what provides a product identifier, instead of receiving a product

identifier (column 5, lines 15-30; column 13, lines 12-57; column 14, lines 31-54; column

15, lines 1-19). However, O Leary discloses providing a product identifier to a needs

analysis module (paragraph beginning "Instead of being subsumed"). Hence, it would

have been obvious to one of ordinary skill in the art of electronic commerce at the time

of applicant's invention for the presentation and/or controls layer to provide a product

identifier to the needs analysis module, for the obvious advantage of enabling users to

obtain configuration information for vehicles and other products which they had

identified for research and possible purchase.

Claims 27, 28, and 30-35

Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Beesley (U.S. Patent 5,907,320) as applied to claim 26 above. Claims 27 and 28

are closely parallel to claims 4 and 5, respectively, and rejected on essentially the same

grounds set forth above with regard to claims 4 and 5.

Claims 30, 31, 32, 33, 34, and 35 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Beesley (U.S. Patent 5,907,320) as applied to claim 29 above and

further in view of the Microsoft Press Computer Dictionary. Claims 30, 31, 32, 33, 34,

and 35 are closely parallel to claims 7, 8, 9, 10, 11, and 12, respectively, and rejected

on essentially the same grounds set forth above with regard to claims 7, 8, 9, 10, 11,

and 12.

Claims 37, 38, 40-43, and 45-48

Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Beesley et al. (U.S. Patent 5,907,320) as applied to claim 36 above, and further in

view of O Leary ("CompuServe Is 'Loaded' with Online Car Info"). As per claim 37,

Beesley does not expressly disclose that the needs analysis module is configured to

permit identification of a product configuration based on product identifier information,

but O Leary teaches identifying a product configuration based on product identifier

information (paragraph beginning "Instead of being subsumed"). Hence, it would have

been obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention for the needs analysis module to be configured to permit

identification of a product configuration based on product identifier information, for the

obvious advantage of enabling users to obtain configuration information for vehicles and other products which they had identified for research and possible purchase.

Claim 38 is rejected on at least the same grounds as 37.

Claims 40, 41, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beesley et al. (U.S. Patent 5,907,320) as applied to claim 36 above. As per claim 40, Beesley does not expressly disclose that the configuration service is configured to provide a configuration list to the needs analysis module in response to a product identifier received from the needs analysis module, but one can define whatever software module is involved in providing lists of the attributes of the various products in Beesley's system as a configuration service, and Beesley does disclose comparing product identifiers identifying products with configuration/attribute data for products, to determine which products match listed attributes (Abstract; column 3, line 4, through column 5, line 30; column 13, lines 12-57).

As per claim 41, Beesley does not expressly disclose that said configuration list is a list of the available features of said product, but such a list of available features would have been obvious for the purpose of enabling Beesley's system to carry out its function of determining which, if any, available products match user-desired attributes (Abstract; column 3, line 4, through column 5, line 30; column 13, lines 12-57).

As per claim 42, Beesley does not expressly disclose that said configuration list is a list of the configurations of said product, but such a list of configurations would have been obvious for the purpose of enabling Beesley's system to carry out its function of

determining which, if any, available products match user-desired attributes (Abstract; column 3, line 4, through column 5, line 30; column 13, lines 12-57).

As per claim 43, Beesley discloses that the database layer comprises a database (Abstract; column 3, lines 36-41; column 4, line 53, through column 5, line 30). Beesley does not expressly disclose that the configuration service is configured to use the product identifier to generate the configuration list from information stored in the database, but given that configuration/attribute information for products stored in the database are compared to attributes to determine which products match listed attributes (Abstract; column 3, line 4, through column 5, line 30; column 13, lines 12-57), generating such configuration lists is held to be obvious, to make the system able to carry out its functions.

Claims 45, 46, 47, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beesley et al. (U.S. Patent 5,907,320) as applied to claim 36 above, and further in view of the Microsoft Press Computer Dictionary. As per claim 45, Beesley does not disclose that the database comprises a configuration table, but the Microsoft Press Computer Dictionary teaches the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise a configuration table, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 46, Beesley discloses that the needs analysis module is configured to access the configuration information, and that the configuration service is configured

to access the database (Abstract; column 3, line 4, through column 5, line 30; column

13, lines 12-57; column 14, lines 31-54). Beesley does not expressly disclose that the

needs analysis module supplies product identifier information to the configuration

service (as well as to the user of the system), or that the configuration service uses

product identifier information to access the database. However, this is a mere verbal

reshuffling. One can describe whatever module of Beesley's system is involved in

receiving the product identifier information (e.g., to be passed to the user) as a

configuration service, and whatever module uses a product identifier to access the

database (e.g., in comparing identified products to desired attributes) as a configuration

service.

As per claim 47, Beesley does not disclose that the configuration table comprises

a configuration record comprising configuration and identifier fields containing

corresponding information, but the Microsoft Press Computer Dictionary teaches the

use of fields in databases (definition of field, sense 1, page 194). Hence, it would have

been obvious to one of ordinary skill in the art of electronic commerce at the time of

applicant's invention to have the configuration table comprise a configuration record

comprising fields which contain corresponding information, for the obvious advantage of

enabling data to be stored using standard techniques for easy storage and access.

As per claim 48, Beesley discloses that said configuration information describes

a configuration of the product (column 4, line 12, through column 5, line 30; column 13,

lines 12-57; column 14, lines 31-54), and product identifier information identifies the

configuration of the product (column 4, line 12, through column 5, line 30; column 13,

lines 12-57; column 14, lines 31-54).

Claims 53-56

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beesley

et al. (U.S. Patent 5,907,320) as applied to claim 52 above, Beesley does not expressly

disclose causing a needs analysis module to provide said attribute to said filter service,

and causing said filter service to return said product identifier to said needs analysis

module, but this essentially follows from regarding the filter service as having a distinct

needs analysis module, which amounts to designating certain circuits, or certain lines of

computer code as a "needs analysis module." This need involve no substantive

difference from Beesley, and is therefore held to be obvious. (To make separable is

considered to be within the level of ordinary skill in the art, *Nerwin v. Erlichman*, 168

USPQ 177, 179 [Board of Patent Appeals and Interferences, 1969]; In re Dulberg, 129

USPQ 348, 349; 289 F.2d. 522 [CCPA 1961].)

Claims 54, 55, and 56 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Beesley et al. (U.S. Patent 5,907,320) as applied to claim 51 above,

and further in view of the Microsoft Press Computer Dictionary. As per claim 54,

Beesley does not disclose accessing an attribute table of said database using said

attribute; accessing said product identifier in a configuration table of said database

using a reference in said attribute table associated with a record of said attribute table

accessed using said attribute, but the Microsoft Press Computer Dictionary teaches the

use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it

would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the database comprise an attribute table and a configuration table, and access those tables, and the data therein, for the obvious advantage of linking relevant data, and enabling efficient access.

As per claim 55, Beesley discloses that said product identifier is associated with a product configuration, and said product configuration represents a product having said attribute (column 4, line 53, through column 5, line 30; column 13, lines 43-57).

As per claim 56, claim 56 is rejected on the same basis as claim 54.

Claims 59-61

Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beesley et al. (U.S. Patent 5,907,320) as applied to claim 58 above. Beesley does not expressly disclose causing a needs analysis module to provide said product identifier to said filter service, and causing said filter service to return said product configuration to said needs analysis module, but this essentially follows from regarding the filter service as having a distinct needs analysis module, which amounts to designating certain circuits, or certain lines of computer code as a "needs analysis module." This need involve no substantive difference from Beesley, and is therefore held to be obvious. (To make separable is considered to be within the level of ordinary skill in the art, *Nerwin v. Erlichman*, 168 USPQ 177, 179 [Board of Patent Appeals and Interferences, 1969]; In re Dulberg, 129 USPQ 348, 349; 289 F.2d. 522 [CCPA 1961].)

Claims 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beesley et al. (U.S. Patent 5,907,320) as applied to claim 57 above, and further in

view of the Microsoft Press Computer Dictionary. As per claim 60, Beesley does not

disclose accessing a configuration table of said database using said product identifier to

identify said product configuration, but the Microsoft Press Computer Dictionary teaches

the use of tables in databases (definition of table, senses 1 and 2, page 459). Hence, it

would have been obvious to one of ordinary skill in the art of electronic commerce at the

time of applicant's invention to have the database comprise a configuration table and a

configuration table, and access that table, and the data therein, for the obvious

advantage of linking relevant data, and enabling efficient access.

As per claim 61, Beesley discloses that said product configuration is associated

with a product identifier (column 4, line 53, through column 5, line 30; column 13, lines

43-57).

Claims 67-68

Claims 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable

over O Leary ("CompuServe Is 'Loaded' with Online Car Info") as applied to claim 64

above, and further in view of official notice. As per claim 67, O Leary does not disclose

that said selected feature is a trim level of said vehicle, but official notice is taken that

the level of trim of vehicles affects people's choices of which vehicles to buy (otherwise,

manufacturers would not likely persist in spending so much on trim and esthetic

features). Hence, it would have been obvious to one of ordinary skill in the art of

electronic commerce at the time of applicant's invention for said selected feature to be a

trim level of said vehicle, for the obvious advantage of assisting people in identifying

and purchasing vehicles with desired trim.

As per claim 68, O Leary does not disclose that said selected feature is an equipment level of said vehicle, but official notice is taken that the level of equipment in vehicles (e.g., engine horsepower, antilock brakes, power steering, automatic windows, air conditioning, etc.) affects people's choices of which vehicles to buy. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for said selected feature to be an equipment level of said vehicle, for the obvious advantage of assisting people in identifying and purchasing vehicles with desired equipment.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Geller et al. (U.S. Patent 5,844,554) disclose methods and systems for user interfaces and constraint handling configurations software. McCann et al. (U.S. Patent 5,963,939) disclose a method and apparatus for an incremental editor technology. Franklin et al. (U.S. Patent 6,125,352) disclose a system and method for conducting commerce over a distributed network. Etzion et al. (U.S. Patent 6,604,093) disclose a situation awareness system. Mikurak (U.S. Patent 6,606,744) discloses providing collaborative installation management in a network-based supply environment.

Morgulis et al. (Canadian Patent Application 2,153,530) disclose automated audio presentations for promoting automobile sales. Nabors et al. (EP 1 001 355 A2) disclose an apparatus and process for facilitating customer-driven sales of products

having multiple configurations. (This publication may not qualify as prior art, but it claims priority to two U.S. applications which may become relevant if published as patents or published patent applications.)

The anonymous article (abstract only), "Ford Finds That Viewdata Gives You More," discloses searching for specific, or similar, models of car. The anonymous article, "Calico Guides Online Car Buyers to Direct European Dealers," discloses a computer software system for matching individual preferences with compatible products, in particular cars.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. (Wynn Coggins is currently on assignment elsewhere in the Patent Office; the examiner's acting supervisor, Jeffrey Smith, can be reached at 703-308-3588.) The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen

**NICHOLAS D. ROSEN
PRIMARY EXAMINER**

September 4, 2004